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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,786	12/11/2000	Yasushi Ichikawa	Q62216	2733

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SUGHRUE, MION, ZINN, MACPEAK & SEAS
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EXAMINER

DUONG, THANH P

ART UNIT PAPER NUMBER

1764

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/732,786	Applicant(s) ICHIKAWA ET AL.	
	Examiner Tom P Duong	Art Unit 1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' remarks filed on November 10, 2004 have been carefully considered.

Claims 1-12 and 16-20 are pending in this application.

Claim Objections

Claim 6 is objected to because of the following informalities: In claim 6, lines 1-2, the recitation of "silicone rubber powder, silicone rubber powder" should read "--silicone rubber powder, silicone resin powder--". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 16 is rejected under 35 U.S.C. 102(b) as being anticipated by Takemura et al. (5,733,977). Takemura discloses a golf ball having at least two pieces (Col. 4, lines 50-58) comprising: a core (1) portion formed of a composition based on at least one of primary resins selected from one group consisting of an ethylene ionomer resin, polyester elastomer, polyurethane elastomer, polyolefin elastomer, polyamide elastomer, polyolefin resin, and styrene block copolymer (Col. 3, lines 18-24) which has

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blended and uniformly dispersed therein at least one of a silicone rubber powder, a silicone resin powder, and a composite powder thereof in a powder form (Col. 2, lines 6-10).

2. Claims 1-2, 5-7, 9-12, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Sullivan (6,270,429). Regarding claims 1, 7, 9-10, and 17, Sullivan discloses a golf ball having at least two pieces (Col. 4, lines 50-58) comprising: a cover (one or more mantle layers) portion formed of a composition based on at least one of primary resins selected from one group consisting of an ethylene ionomer resin, polyester elastomer, polyurethane elastomer, polyolefin elastomer, polyamide elastomer, polyolefin resin, and styrene block copolymer (Col. 3, lines 18-24) which has blended and uniformly dispersed therein at least one of a silicone rubber powder, a silicone resin powder, and a composite powder thereof in a powder form (Col. 2, lines 6-10). Regarding claim 2, Sullivan discloses the composite powder comprises silicone rubber particles surface coated with a silicone resin (Col. 6, lines 38-55). Regarding claims 5-6, and 18-20, Sullivan discloses the silicone rubber powder has particle sizes and the blended amount as claimed (Col. 6, lines 32-38 and Col. 5, lines 15-21). Regarding claims 11 and 12, Sullivan discloses the ethylene ionomer resin (Col. 12, lines 8-50) and a Shore D hardness and a meth(acrylic) acid content (Col. 12, lines 53-60) of the claimed invention.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3-4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan '429 in view of Ueshima et al. (5,502,095). Regarding claims 3-4, and 8, Sullivan '429 does not disclose expressly the type of silicone rubber powder with functional group of the claimed invention. Ueshima et al. discloses the thermoplastic elastomer composition consist of component (C), polyorganosiloxane. Polyorganosiloxane is blended with resin or rubber or filler such as a silicone rubber powder. (Col. 6, line 61-65). Ueshima further teaches that this blended composition can be used as an elemental material for sport and leisure goods (e.g. golf club grip, baseball ball bat grip, swimming and etc.) and other rubber contacts (Col. 11, lines 40-45). The use of such polyorganosiloxane improves material properties such as fatigue resistance, abrasion resistance, and flexibility (Col. 11, lines 25-27). Ueshima et al. discloses the thermoplastic elastomer composition consist of component (C), polyorganosiloxane. Polyorganosiloxane is blended with resin or rubber or filler such as a silicone rubber powder. (Col. 6, line 61-65). Thus, it would have been obvious in view of Ueshima to one having ordinary skill in the art to modify the silicone cover (mantle layers) of Sullivan with polyorganosiloxane as taught by Ueshima in order to gain the

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above benefits. In addition, such commercially available silicone resin powder is known in the art and it would have been obvious to use such silicone rubber powder here to improve hardness and durability. Furthermore, Applicant has not disclosed the advantage and/or criticality of using the silicone rubber powder with such functional groups; thus, it appears the material selection is an obvious matter of design choice. Therefore, it appears the silicone resin powder of above applied references provide a golf ball with the same performance as the claimed invention.

Response to Arguments

Applicant's arguments with respect to claims 1-12 and 16-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom P Duong whose telephone number is (571) 272-2794. The examiner can normally be reached on 8:00AM - 4:30PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tom Duong
January 24, 2005

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Glenn Caldarola
Supervisory Patent Examiner
Technology Center 1700